2216

SUPREME COURT OF THE UNITED STATES.

No. 171.

JULIA P. HOTCHKISS, EXECUTRIX, &c., AND AL., PLAINTIFFS IN ERROR,

vs.

MILES GREENWOOD AND THOMAS WOOD.

IN ERROR TO THE CIRCUIT COURT UNITED STATES FOR OHIO.

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Gideon & Co., Printers.

The United States of America, to the honorable the judges of the circuit court of the United States, for the seventh circuit and district of Ohio, greeting:

Whereas in the record and process, and also in the rendering judgment, in a certain action of trespass on the case which was in the said court, between Julia P. Hotchkiss, executrix of John G. Hotchkiss, deceased, John A. Davenport, and John W. Quincey, plaintiffs, and Miles Greenwood and Thomas Wood, partners, &c., defendants, manifest error hath intervened, as it is said, to the great damage of the said Julia P. Hotchkiss, executrix, &c., et al., John A. Davenport, and John W. Quincey, as by their complaint we are informed; and we being willing that the error aforesaid (if any) be corrected, and full and speedy justice be done in this behalf to the said parties, command you that the record, process, and judgment aforesaid, with all things touching the same, under your seals, distinctly and plainly, without delay, you send and certify to the judges of the Supreme Court of the United States, on the first day of the next term of said court, so that the judgment aforesaid being inspected, the court may further, for correcting the error aforesaid, do that which of right and according to law ought to be done.

Witness the honorable Roger B. Taney, chief justice of the United States of America, this twenty-first day of December, in the [L. S.] year of our Lord one thousand eight hundred and forty-eight, and in the seventy-third year of the American independence.

Attest, WM. MINER, *Clerk.*

We hereby waive the issuance of the usual citation, and acknowledge notice of the above writ of error.

MILES GREENWOOD,
THOMAS WOOD,
By CHAS. FOX, *their attorney.*

Cincinnati, Ohio, December 23d, A. D. 1848.

Pleas begun and held at the court-house, in the city of Columbus, on the third Monday in the month of July, being the seventeenth day of that month, in the year of our Lord one thousand eight hundred and forty-eight, and of the independence of the United States of America the 73d, before the honorable John McLean and the honorable Humphrey H. Leavitt, judges of the circuit court of the United States, in and for the seventh circuit and district of Ohio:

Among other proceedings there was the following, to wit:

JULIA P. HOTCHKISS, executrix of John G. Hotchkiss, deceased, and John A. Davenport, and John W. Quincy,
vs.
MILES GREENWOOD and Thomas Wood, partners, &c.
} In case.

Be it remembered that heretofore, to wit, on the eighteenth day of

October, in the year of our Lord eighteen hundred and forty-five, came the plaintiffs, by Messrs. Taft and Key, their attorneys, and sued out of the clerk's office of said court a certain writ of summons ad respondendum against the said defendants, in the words and figures, to wit:

UNITED STATES OF AMERICA, *district of Ohio, ss.*

To the marshal of said district, greeting:

We command you to summon Miles Greenwood and Thomas Wood, partners in trade under the name of "M. Greenwood & Co.," citizens of and residents in the State of Ohio, if they be found in your bailiwick, to be and appear before the judges of the circuit court of the United States, for the district of Ohio aforesaid, at Columbus, on the third Monday in the month of December next, to answer unto John A. Davenport and John W. Quincy, of a plea of trespass on the case; damages five thousand (5,000) dollars; and have then there this writ.

Witness the honorable Roger B. Taney, chief justice of the United States, this 18th day of October, 1845, and in the 70th year [SEAL.] of the independence of the United States of America.

Attest, WM. MINER, *Clerk.*

Upon which writ of summons is endorsed the following causes of action, to wit:

"Suit brought for infringing the plaintiff's patent right for making and selling a new and useful improvement in making door and other knobs of all kinds of clay used in pottery and porcelain.

"TAFT & KELLEY,

"*Atty's for pl'ffs, and security for costs.*"

And afterwards, to wit, at the November term of said court, in the year of our Lord eighteen hundred and forty-five, being the time to which said writ of summons was made returnable, came the marshal of said district, to whom the same was in form aforesaid directed, and returned said writ into court here, with his proceedings endorsed thereon, in the words and figures following, to wit:

"Served on the within named defendants, Miles Greenwood and Thomas Wood, by delivering a copy to each of them, personally, this first day of November, A. D. 1845.

"D. A. ROBERTSON, *Marshal.*

"By HENRY ROEDLER, *Deputy.*

"Fees $10 00."

And thereupon this cause was continued.

And afterwards, to wit, on the seventh day of May, in the year of our Lord one thousand eight hundred and forty-six, came the plaintiffs aforesaid, by their attorneys, and filed in the clerk's office of said court their declaration in this case, which is in the words and figures following, to wit:

CIRCUIT COURT OF THE UNITED STATES,
For the seventh circuit and district of Ohio, ss.

Julia P. Hotchkiss, as executrix of the last will and testament of John G. Hotchkiss, late of the county of New Haven, in the State of Connecticut, deceased, and John A. Davenport, and John W. Quincy, of the city and county of New York and State of New York, plaintiffs in this suit, by Taft & Key, their attorneys, complain of Miles Greenwood and Thomas Wood, partners in trade under the firm of "M. Greenwood & Co.," defendants, summoned to answer the plaintiffs in a plea of trespass on the case.

For that the said John G. Hotchkiss, in his lifetime, the said John A. Davenport and John W. Quincy, were the original and first inventors of a certain new and useful improvement in making door and other knobs, in the letters patent hereinafter mentioned and fully described, the same being "a new and useful improvement in making door and other knobs of all kinds of clay used in pottery and porcelain," which was not known or used before their said invention, and which was not at the time of their application for a patent, as hereinafter mentioned, in public use or on sale with their consent or allowance. And the said John G. Hotchkiss in his lifetime, and the said John A. Davenport and John W. Quincy, being so as aforesaid the inventors thereof, and being also citizens of the United States, on the twenty-ninth day of July, in the year of our Lord one thousand eight hundred and forty-one, upon due application therefor, did obtain certain letters patent therefor, in due form of law, under seal of the Patent office of the United States, signed by the Secretary of State, and countersigned by the Commissioner of Patents of the United States, bearing date the day and year aforesaid, whereby there was secured to the said John G. Hotchkiss, then living, the said John A. Davenport and John W. Quincy, their heirs, administrators, executors, or assigns, for the term of fourteen years from and after the date of the patent, the full and exclusive right and liberty of making, using, and vending to others to be used, the said invention, as by the said letters patent in court to be produced will fully appear. And the plaintiffs further say, that from the time of granting of the said letters patent as aforesaid hitherto, the said John G. Hotchkiss in his lifetime, and since his death the said Julia P. Hotchkiss, as his executrix, and the said John A. Davenport and John W. Quincy, have made, used, and vended to others to be used, the said invention, to their great advantage and profit. Yet the said defendants, well knowing the premises, but contriving to injure the plaintiffs, did, since the death of said John G. Hotchkiss, viz., on the first day of January, in the year eighteen hundred and forty-five, and at divers times before and afterwards, during the term of fourteen years mentioned in said letters patent, and before the purchase of this writ, at Cincinnati, in the county of Hamilton, in the district aforesaid, unlawfully and wrongfully, and without the consent or allowance and against the will of the plaintiffs, make, use, and vend to others to be used, the said invention, in violation and infringement of the exclusive right so

secured to the plaintiffs by said letters patent as aforesaid, and contrary to the form of the statute of the United States in such case made and provided, whereby the plaintiffs have been greatly injured and deprived of great profits and advantages which they might and otherwise would have derived from said invention, and have sustained actual damage to the amount of five thousand dollars, and by force of the statute aforesaid an action has accrued to them to recover the said actual damage, and such additional amount, not exceeding in the whole three times the amount of such actual damage, as the court may see fit to order and adjudge. Yet the said defendants, though often requested thereto, have never paid the same, or any part thereof, to the plaintiffs, but have refused and yet refuse so to do; and therefore they bring their suit, &c.

TAFT & KEY,
Attorneys for plaintiffs.

And afterwards, to wit, at rules held in the clerk's office of said court, on the first Monday of June, in the year of our Lord one thousand eight hundred and forty-six, came the plaintiffs, by their attorneys, and entered a rule on the said defendants to plead to said declaration by the July rule day next ensuing; at which time, to wit, at rules held as aforesaid, on the first Monday of July, in the year last aforesaid, came again the said plaintiffs, by their attorneys, and the said defendants having failed to plead as they were ruled to do, judgment by default was entered against them according to the rules of said court, to be inquired of, &c. And afterwards, to wit, at the July term of said court, in the year last aforesaid, "on motion to the court, and by consent of the parties, plaintiffs and defendants, the original writ in this cause is ordered to be amended by inserting the name of Julia P. Hotchkiss, as executrix of John G. Hotchkiss, deceased, as a joint plaintiff with John A. Davenport and John W. Quincy, and said amendment is accordingly made, and the defendants are ruled to plead by the next rule day, and this cause is continued. And afterwards, to wit, at the November term of said court, in the year last aforesaid, this cause was continued. And afterwards, to wit, at the July term of said court, in the year of our Lord eighteen hundred and forty-seven, on motion of the defendants, by their attorney, the default entered herein at rules is set aside; and thereupon the said defendants, by their attorneys, filed their plea, which is in the words and figures following, to wit:

JULIA A. HOTCHKISS, executrix of John G. Hotchkiss, deceased, John A. Davenport and John W. Quincy,
vs.
MILES GREENWOOD and Thomas R. Wood.

7th circuit of the United States, Ohio district.

And the said Miles Greenwood and Thomas R. Wood, by Charles Fox, their attorney, come and defend the wrong, &c., when, &c., and for plea say, they are not guilty of the premises set forth in

the plaintiffs' declaration, and of this they put themselves upon the country, and the plaintiffs do the like.

Notice.

The plaintiffs will please take notice, that on the trial of the above cause the defendants will give in evidence to the jury, that the said John G. Hotchkiss, John A. Davenport, and John W. Quincy were not the original and first inventors and discoverers of making or manufacturing knobs of potter's clay or of porcelain. They will also prove that the making of knobs from potter's clay, and also from porcelain, and other clays used by potters, was known and practised, and such knobs were made, used, and sold, in the cities of New York, Albany, Troy, and Brooklyn, in the State of New York; also in Jersey City, in the State of New Jersey; also in the city of Philadelphia, State of Pennsylvania, by John Mayer, Thomas Frere, William Lundy, jr., and Charles W. Vernerck, residing in the city of New York; also by John Harrison, residing in Jersey City, in the State of New Jersey; and by Littlefield, Hattrick & Shannon, of Philadelphia, in the State of Pennsylvania, long before the 29th day of July, in the year 1841, the date of the patent in the declaration mentioned. They will also prove that similar knobs were manufactured of potter's clay, and also of porcelain, and were also used and sold long prior to the said twenty-ninth day of July, 1841, in the town of Burslem, in Staffordshire, England; also in the town of Sandyford, near Tunstall; also in the town of Hanley, Staffordshire, England; also at Woodenbose village, in the county of Derbyshire, England. And the said defendants will prove the manufacture and use of said knobs; so made of clay and porcelain, by Godfrey Webster, John Webster, who now reside in East Liverpool, Columbiana county, Ohio; and also by Enock Bulloch, who now resides in Wellsville, in the same county; also by Daniel Bennett, who now [resides] in the city of Pittsburgh, Pennsylvania; all of whom formerly resided in Staffordshire, England. The defendants will also prove that the said patentees, John G. Hotchkiss, John A. Davenport, and John W. Quincy, at the time of making application for the said patent, well knew that the said knobs so patented had been previously made and sold in a foreign country, to wit, at the kingdom of Great Britain, and also in Germany, and did not believe themselves to be the first inventors or discoverers of manufacturing knobs from potter's clay or porcelain. All of which will be insisted upon in bar of the action.

CHAS. FOX,
Attorney for the defendants.

And thereupon, on application of defendants, it is ordered, that this cause be continued at defendants' costs, and by assent of plaintiffs and defendants, all formal objections to the officer or the manner of taking or certifying any depositions now on file in this cause are waived.

And afterwards, to wit, at the November term of said court, in the year last aforesaid, this cause was continued.

And afterwards, to wit, on the eighteenth day of July, being at the

July term of said court, in the year of our Lord one thousand eight hundred and forty-eight, on motion of the defendants, by their attorneys, leave is given to file an additional notice in this cause, which is filed accordingly, and is in the words and figures following, to wit:

WOOD & GREENWOOD
ads.
JULIA HOTCHKISS, executrix, and others.

7th circuit court of the United States.

Additional notice.

The plaintiffs in this cause will please take notice, that on the trial of the cause the defendants will give in evidence to the jury that the said John G. Hotchkiss, John A. Davenport, and John W. Quincy, were not the original and first inventors and discoverers of making or manufacturing knobs of potter's clay, or of porcelain; they will also prove that knobs made of potter's clay, and of porcelain, and other clays, had been previously publicly used and sold in the cities of New York, Albany, Troy, and Brooklyn, in the State of New York; also in Jersey city, in the State of New Jersey; also in New Haven and Middletown, in the State of Connecticut, long before and at the date of the patent under which the plaintiffs claim; the defendants will likewise prove on said trial that John Mayer, residing in Staten Island; Hoope & Lee, residing in the city of Brooklyn, in the State of New York; Edward H. Higgins, Jno. Penfield, John Duntze, residing in New Haven, in the State of Connecticut; Mathew Fifo, William Fifo, Jane Fifo, John C. Smith, and certain persons doing business under the name of Smith, Fifo & Co., residing in the city of Philadelphia, in the State of Pennsylvania, as early as the year 1831, and from that time on, and until, and at the time of obtaining the patent under which the plaintiffs claim, and before the alleged discovery and invention set forth in said patent, made, manufactured, and publicly sold and used knobs made of potter's clay, and of other clays, and of porcelain, in the several cities and places named.

And afterwards, to wit, on the twenty-sixth day of July, in the year and at the term last mentioned of said court, came the parties by their attorneys, and thereupon, for trying the issue joined, came a jury, to wit, Daniel Chambers, John Watt, Parley Carlin, James Mauary, Littleton Quinton, John Cochran, Phillip W. Spargur, George A. B. Lazello, Alfred Harris, S. M. Raisbeck, Calvin Starr, and John H. Purdy, who were duly empannelled, and sworn, and affirmed, to speak the truth upon the issue joined between the parties; but the investigation of this cause not being completed, the court adjourned the jury until to-morrow morning at 8½ o'clock.

And afterwards, to wit, on the twenty-seventh day of July, in the same year, and at the term last mentioned of said court, came the parties aforesaid by their attorneys, and also the jurors aforesaid, and the investigation of the case not being completed, the court adjourned the jury until to-morrow morning at 8½ o'clock.

And afterwards, to wit, on the twenty-ninth day of July, in the year and at the term last aforesaid mentioned of said court, came the parties aforesaid by their attorneys, and also the jurors aforesaid, and the investigation of this cause being completed, the said jurors upon their oaths and affirmations do say, that the said defendants are not guilty in manner and form as the said plaintiffs have complained against them; therefore, it is considered that the said defendants go hence without day, and recover of the said plaintiffs their costs herein expended, taxed to $

And afterwards, to wit, on the fourth day of August, in the year and at the term last aforesaid of said court, the following order was entered in this case, to wit, on the trial of this cause the said plaintiffs, by their attorneys, tendered a bill of exceptions to the opinion of the court upon the opinions set forth in said bill of exceptions, and prayed that the same might be signed and sealed by the court, and made a part of the record in this case, which is accordingly done, and is in the words and figures following, to wit:

JULIA P. HOTCHKISS, executrix of John G. Hotchkiss, John A. Davenport, and John W. Quincy,

vs.

MILES GREENWOOD and Thomas Wood.

Action of the case for infringment of a patent right, tried July T., of 7th cir., district of Ohio.

The plaintiffs offered in evidence the patent specifications and drawings attached thereto, which are in the words and figures following, viz.:

The United States of America, to all to whom these letters patent shall come.

Whereas, John G. Hotchkiss, New Haven, Conn., John A. Davenport, and John W. Quincy, New York, have alleged that they have invented a new and useful improvement in making door and other knobs, of all kinds of clay used in pottery, and of porcelain, which they state has not been known or used before their application; have made oath that they are citizens of the United States, that they do verily believe that they are the original and first inventors or discoverers of the said improvement, and that the same hath not, to the best of their knowledge and belief, been previously known or used; have paid into the treasury of the United States the sum of thirty dollars, and presented a petition to the Commissioner of Patents signifying a desire of obtaining an exclusive property in the said improvement, and praying that a patent may be granted for that purpose: These are therefore to grant, according to law, to the said John G. Hotchkiss, John A. Davenport, and John W. Quincy, their heirs, administrators, or assigns, for the term of fourteen years from the twenty-ninth day of July, one thousand eight hundred and forty-one, the full and exclusive right and liberty of making, constructing, using, and vending to others to be used, the said improvement, a description whereof is given in the words of

the said Hotchkiss, Davenport, and Quincy, in the schedule hereunto annexed, and is made a part of these presents.

In testimony whereof I have caused these letters to be made patent, and the seal of the Patent office has been hereunto affixed. Given under my hand at the city of Washington, this twenty-ninth day of July, in the year of our Lord one thousand eight hundred forty-one, and of the independence of the United States of America the sixty-sixth.

[Seal of the Patent Office.]

DANIEL WEBSTER,
Secretary of State.

Countersigned and sealed with the seal of the Patent office.

HENRY L. ELLSWORTH,
Commissioner of Patents.

The schedule referred to in these letters patent, and making a part of the same—to all whom it may concern:

Be it known that we, John G. Hotchkiss, of the city and county of New Haven, and State of Connecticut, and John A. Davenport and John W. Quincy, both of the city, county, and State of New York, have invented an improved method of making knobs for locks, doors, cabinet furniture, and for all other purposes which wood and metal, or other material knobs, are used. This improvement consists in making said knobs of potter's clay, such as is used in any species of pottery; also of porcelain; the operation is the same as in pottery, by moulding, turning, and burning, and glazing; they may be plain in surface and color, or ornamented to any degree in both; the modes of fitting them for their application to doors, locks, furniture, and other uses, will be as various as the uses to which they may be applied, but chiefly predicated on one principle, that of having the cavity in which the screw or shank is inserted, by which they are fastened, largest at the bottom of its depth, in form of a dove tail, and a screw formed therein by pounding in metal in a fused state. In the annexed drawing, A represents a knob with a large screw inserted, for drawers and similar purposes; B represents a knob with a shank to pass through and receive a nut; C the head of the knob calculated to receive a metallic neck; D a knob with a shank calculated to receive a nut on the outside or front. What we claim as our invention, and desire to secure by letters patent, is the manufacturing knobs, as stated in the foregoing specifications, of potter's clay, or any kind of clay used in pottery, and shaped and finished by moulding, turning, burning, and glazing; and also of porcelain.

JOHN. G. HOTCHKISS,
J. A. DAVENPORT,
JOHN W. QUINCY.

Witnesses: ALPS. SHERMAN,
JAMES MONTGOMERY.

[For drawings, see original, page 14.]

We do hereby certify, that the above drawings are a correct representation of the improved articles referred to in the annexed specification.

JOHN G. HOTCHKISS,
J. A. DAVENPORT,
JOHN W. QUINCY.

Witnesses: SAM'L BLYDENBURGH,
JAMES MONTGOMERY.

And other evidence, tending to prove the originality, novelty, and usefulness of the inventions as described in said specification; and other evidence, tending to show the violation of said patent by the defendant, and rested. Whereupon the defendants offered evidence tending to show that the said alleged invention was not originally invented by any one of the said patentees; and that, if said invention was original with any of the said patentees, it was not the joint invention of all of said patentees; and other evidence, tending to show that the mode of fastening the shank or collet to the knob, adopted by the plaintiffs, and in said specification described, had been known and used in Middletown, Connecticut, prior to the alleged inventions of the plaintiffs, as a mode of fastening shanks or collets to metallic knobs. And the evidence being closed, the counsel for the plaintiffs insisted in the argument that, although the knob, in the form in which it is patented, may have been known and used in the United States prior to their invention and patent; and although the shank and spindle, by which it is attached, may have been known and used in the United States prior to said invention and patent, yet if such shank and spindle had never before been attached to a knob made of potter's clay or porcelain, and if it required skill and thought and invention to attach the said knob of clay to the metal shank and spindle, so that the same would unite firmly and make a solid and substantial article or manufacture; and if the said knob of clay or porcelain so attached were an article better and cheaper than the knob theretofore manufactured of metal or other materials, that the patent was valid, and asked the court so to instruct the jury, which the court refused to do; but, on the contrary thereof, instructed the jury, that if knobs of the same form and for the same purposes with that described by the plaintiffs in their specifications, made of metal or other material, had been known and used in the United States prior to the alleged invention and patent of the plaintiffs, and if the spindle and shank, in the form used by the plaintiffs, had before that time been publicly known and used in the United States, and had been theretofore attached to metallic knobs by means of the dovetail and the infusions of melted metal, as the same is directed in the specification of the plaintiffs to be attached to the knob of potter's clay or porcelain, so that if the knob of clay or porcelain is the mere substitution of one material for another, and the spindle and shank be such as were theretofore in common use, and the mode of connecting them to the knob by dovetail be the same that was theretofore in use in the United States, the material being in common use, and no other ingenuity or skill being necessary to construct the

knob than that of an ordinary mechanic acquainted with the business, the patent is void and the plaintiffs are not entitled to recover. The counsel for the defendants asked the court to instruct the jury, that if they should be satisfied that any one of the patentees was the original inventor of the article in question, and that the same was new and useful, yet if they should be satisfied from the evidence that all the patentees did not participate in the invention, the patent is void and the plaintiffs cannot recover. The court gave the above, modified by the remark, that the patent was prima facie evidence that the invention was joint, though the fact might be disproved on the trial; and the court remarked, there was no evidence except that of a slight presumption against the joint invention as proved by the patent; to which refusal of the court to instruct the jury as asked by the counsel for the plaintiffs, and to the instructions given, the plaintiffs, by their counsel, except and pray the court to sign this their bill of exceptions.

JOHN McLEAN. [SEAL.]

THE UNITED STATES OF AMERICA,
District of Ohio, ss.

I, William Miner, clerk of the circuit court of the United States, in and for the seventh circuit and district of Ohio, do hereby certify, that the foregoing is truly taken and copied from the record of the proceedings of said circuit court.

In testimony whereof I have hereunto subscribed my name, and affixed the seal of said court, at the city of Columbus, this [L. S.] 25th day of November, A. D. 1848, and in the 73d year of the independence of the United States of America.

Attest, WM. MINER, *Clerk.*

I allow a writ of error in this case. The clerk will issue it on the plaintiffs giving bond and security in five hundred dollars.

JOHN McLEAN,
Justice, Sup. court, U. S.

Nov. 27, 1848.